

am



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/813,192	03/20/2001	Hiroaki Shinohara	08238.008	1732

20480 7590 04/05/2005

STEVEN L. NICHOLS
RADER, FISHMAN & GRAVER PLLC
10653 S. RIVER FRONT PARKWAY
SUITE 150
SOUTH JORDAN, UT 84095

EXAMINER

SHELEHEDA, JAMES R

ART UNIT PAPER NUMBER

2614

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/813,192

Applicant(s)

SHINOHARA, HIROAKI

Examiner

James Sheleheda

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 31 and 32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-30, drawn to embedding an electronic publication into a television signal, classified in class 725, subclass 51.
 - II. Claims 31 and 32, drawn to a television device receiving streamed data from the Internet, classified in class 725, subclass 110.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as a television system allowing a user freely access content on the Internet. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

2. During a telephone conversation with Steven Nichols on 03/28/05 a provisional election was made without traverse to prosecute the invention of group I, claims 1-30. Affirmation of this election must be made by applicant in replying to this Office action. Claims 31 and 32 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claimed television signal of claim 1 consists solely of Nonfunctional Descriptive Material. Such "descriptive material" is not a process, machine, manufacture or composition of matter.

See MPEP § 2106.

5. To expedite a complete examination of the instant application the claims rejected under 35 U.S.C 101 above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 102

Art Unit: 2614

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-3, 7-10, 13-17, 20-26 and 28-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Hendricks (5,986,690).

As to claim 1, Hendricks discloses a television signal (column 4, lines 17-25) comprising:

television programming (column 4, lines 6-8 and lines 17-25); and

an electronic publication (inserted text of a book; column 3, lines 43-48 and lines 65-67 and column 4, lines 1-4).

As to claim 2, Hendricks discloses wherein said signal is digital (column 3, lines 43-48).

As to claim 3, Hendricks discloses wherein said signal is analog (column 3, lines 43-48).

As to claim 7, Hendricks discloses a method of distributing an electronic publication (column 4, lines 6-16), said method comprising:

incorporating data for said electronic publication in a television signal along with television programming (column 3, lines 34-38 and column 4, lines 17-25); and broadcasting said television signal to users (column 3, lines 40-43).

As to claim 8, Hendricks discloses receiving said television signal (column 3, lines 40-48); and

extracting said electronic publication from said television signal (column 3, lines 40-48).

As to claim 9, Hendricks discloses storing said electronic publication for later retrieval (column 7, lines 51-57).

As to claim 10, Hendricks discloses controlling access and output of said electronic publication to a video monitor with a user input device (column 12, lines 18-52).

As to claim 13, Hendricks discloses billing recipients for said electronic publication (column 4, lines 45-48).

As to claim 14, Hendricks discloses ordering said electronic publication (column 4, lines 45-48).

As to claim 15, Hendricks discloses a system for distributing an electronic publication, said system comprising:

a television signal broadcasting headend (operations center; column 3, lines 59-67 and column 4, lines 1-16), wherein a television signal broadcast from said headend comprises television programming and an electronic publication (column 4, lines 3-25); and

a personal video recorder (library, 262 containing the video connector; Fig. 8) for extracting said electronic publication from said television signal for use by a user (column 8, lines 5-59).

As to claim 16, Hendricks discloses wherein said personal video recorder further comprises a digital storage device (storage unit, 600) for recording said electronic publication (column 8, lines 50-59).

As to claim 17, Hendricks discloses wherein said digital data storage device is a hard disk drive (column 8, lines 61-66).

As to claim 20, Hendricks discloses a remote control unit (column 16, lines 25-29) for controlling said personal video recorder to access and output said electronic publication to a video monitor connected to said personal video recorder (column 12, lines 18-52).

As to claim 21, Hendricks further discloses wherein said personal video recorder further comprises an external data connection for downloading said electronic publication to a computer (external book viewer; column 10, lines 37-44 and column 11, lines 24-45).

As to claim 22, Hendricks disclose wherein said broadcasting headend further comprises a subscriber billing system (278) for tracking distribution of electronic publications and billing recipients for said electronic publications (column 4, lines 45-48).

As to claim 23, Hendricks discloses a system for distributing an electronic publication (Fig. 2), said system comprising:

first means (operations center, 250) for broadcasting a television signal comprising both television programming and an electronic publication (column 4, lines 5-25); and

second means for receiving said television signal (library, 262 containing the video connector; Fig. 8) and extracting said electronic publication from said television signal for use by a user (column 8, lines 5-59).

As to claim 24, Hendricks discloses wherein said second means further comprise means for recording (storage unit, 600) said electronic publication (column 8, lines 50-59).

As to claim 25, Hendricks discloses wherein said means for recording comprise a hard disk drive (column 8, lines 61-66).

As to claim 26, Hendricks discloses wherein said second means further comprise a connection to an electronic data network (column 5, lines 9-17).

As to claim 28, Hendricks discloses means for controlling said second means to access and output said electronic publication to a video monitor connected to said second means (column 12, lines 18-52).

As to claim 29, Hendricks further discloses wherein said second means further comprises means for downloading said electronic publication to a computer (external book viewer; column 10, lines 37-44 and column 11, lines 24-45).

As to claim 30, Hendricks disclose wherein said first means further comprise means (278) for tracking distribution of electronic publications and billing recipients for said electronic publications (column 4, lines 45-48).

8. Claims 1-12, 15, 16, 18-20, 23, 24 and 26-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Matthews, III et al. (Matthews) (6,631,523).

As to claim 1, Matthews discloses a television signal (Fig. 1; column 5, lines 41-49) comprising:

television programming (column 5, lines 41-49 and column 6, lines 21-32); and
an electronic publication (EPG information transmitted with the television programming; Fig. 1, column 6, lines 21-64).

As to claim 2, Matthews discloses wherein said signal is digital (column 6, lines 42-44).

As to claim 3, Matthews discloses wherein said signal is analog ((column 6, lines 42-44).

As to claim 4, Matthews discloses wherein said electronic publication comprises at least one hyperlink referencing a site on an electronic data network (column 9, lines 54-67 and column 10, lines 1-11).

As to claim 5, Matthews discloses wherein said electronic publication comprises an embedded video clip (column 7, lines 12-20).

As to claim 6, Matthews discloses wherein said electronic publication comprises an embedded audio clip (column 7, lines 12-20).

As to claim 7, Matthews discloses a method of distributing an electronic publication (Fig. 1; column 5, lines 41-49), said method comprising:

incorporating data for said electronic publication in a television signal along with television programming (EPG information transmitted with the television programming; Fig. 1, column 6, lines 21-64); and

broadcasting said television signal to users (column 5, lines 41-49 and column 6, lines 21-32).

As to claim 8, Matthews discloses receiving said television signal (column 5, lines 50-54); and

extracting said electronic publication from said television signal (column 7, lines 31-40 and column 9, lines 43-54).

As to claim 9, Matthews discloses storing said electronic publication for later retrieval (column 7, lines 31-40).

As to claim 10, Matthews discloses controlling access and output of said electronic publication to a video monitor with a user input device (remote control, 30; column 5, lines 50-67).

As to claim 11, Matthews discloses embedding at least one of a hyperlink referencing a data network site (column 9, lines 54-67 and column 10, lines 1-11), a

Art Unit: 2614

video clip (column 7, lines 12-20) or an audio clip (column 7, lines 12-20) in said electronic publication (Fig. 5).

As to claim 12, Matthews discloses accessing said referenced network site upon selection of said hyperlink (column 9, lines 54-67 and column 10, lines 1-11).

As to claim 15, Matthews discloses a system for distributing an electronic publication (Fig. 1), said system comprising:

a television signal broadcasting headend (22; column 5, lines 41-49), wherein a television signal broadcast from said headend comprises television programming (column 5, lines 41-49) and an electronic publication (EPG information transmitted with the television programming; Fig. 1, column 6, lines 21-64); and

a personal video recorder (set top, 26) for extracting said electronic publication from said television signal for use by a user (column 7, lines 31-40 and column 9, lines 43-54).

As to claim 16, Matthews discloses wherein said personal video recorder further comprises a digital storage device (Fig. 4, program memory, 96) for recording said electronic publication (Fig. 4, 104; column 8, lines 50-60).

As to claim 18, Matthews further discloses wherein said personal video recorder further comprises a connection to the Internet and an Internet browser (column 7, lines 15-20 and column 8, lines 60-65).

As to claim 19, Matthews discloses wherein said electronic publication comprises at least one hyperlink referencing a site on an electronic data network to which said personal video recorder is connected (column 9, lines 54-67 and column 10, lines 1-11).

As to claim 20, Matthews discloses a remote control unit (remote control, 30) for controlling said personal video recorder (column 5, lines 50-67) to access and output said electronic publication to a video monitor connected to said personal video recorder (column 5, lines 50-67 and column 8, lines 50-60).

As to claim 23, Matthews discloses a system for distributing an electronic publication (Fig. 1), said system comprising:

first means (headend, 22) for broadcasting a television signal comprising both television programming (column 5, lines 41-49) and an electronic publication (EPG information transmitted with the television programming; Fig. 1, column 6, lines 21-64);
and

second means for receiving said television signal (set top, 26) and extracting said electronic publication from said television signal for use by a user (column 7, lines 31-40 and column 9, lines 43-54).

As to claim 24, Matthews discloses wherein said second means further comprise means for recording (Fig. 4, program memory, 96) said electronic publication (Fig. 4, 104; column 8, lines 50-60).

As to claim 26, Matthews discloses wherein said second means further comprise a connection to an electronic data network (column 9, lines 54-67 and column 10, lines 1-11).

As to claim 27, Matthews discloses wherein said electronic publication comprises at least one hyperlink referencing a site on said network (column 9, lines 54-67 and column 10, lines 1-11).

As to claim 28, Matthews discloses means for controlling said second means (remote control, 30) to access and output said electronic publication to a video monitor connected to said second means (column 5, lines 50-67 and column 8, lines 50-60).

Conclusion

9. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

on _____
(Date)

Typed or printed name of person signing this certificate:

Signature: _____

Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703)_____ - _____ on _____
(Date)

Typed or printed name of person signing this certificate:

Signature: _____

Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Sheleheda whose telephone number is (571) 272-7357.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James Sheleheda
Patent Examiner
Art Unit 2614

JS



JOHN MILLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600